

R E M A R K S

Claims **19 - 21 and 37 -40** are pending in the present application.

Claims **19, 20 and 37** are independent.

Claim Objections

Claims **23, 24, 27, 29 and 31** were objected to. These claims have been canceled, rendering the rejection moot.

Claim Amendments

Independent claim **37** has been amended to include a limitation from dependent claim **38**.

Thus, independent claim **37** (as amended) is not narrower than claim **38** (before amendment). Thus, this amendment does not require a new search.

Dependent claim **38** has been amended to remove the limitation added to independent claim **37**.

The claims that were canceled were canceled to expedite prosecution and issuance. No amendment was made for a reason related to patentability. Applicants preserve the right to pursue the subject matter of the canceled claims in one or more continuing applications.

Section 112, ¶ 2 Rejections

Claims **19, 20, 21 and 38** stand rejected as being indefinite. Applicants traverse this rejection.

Specifically, all claims rejected as indefinite recite an "entertainment program". The subsequent recital in those claims of the term "the program" clearly is not indefinite. In other words, the objected-to term "program" is not indefinite merely because it does not include each and every word of the previously recited term "entertainment program".

Explicit antecedent basis (i.e. recitation of each and every word previously used) is not required. It is common practice to use an abbreviated form of a term to render a claim clearer and easier to read, provided the abbreviated form cannot be confused as referring to more than one previous term.

MPEP § 2173.05(e) explains this issue:

"Obviously, however, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite."

MPEP § 2173.05(e) also provides an example where a first use of the term *"a controlled stream of fluid"* provides antecedent basis for subsequent use of the term *"the controlled fluid"*.

Similarly, the scope of each claim rejected as indefinite is reasonably ascertainable by those skilled in the art.

Nevertheless, to expedite prosecution and issuance, the claims have been amended to make explicit what was implicit.

Obviousness-type Double Patenting Rejections

The claims stand rejected for obviousness-type double patenting in light of U.S. Patent No. 6,131,086.

A terminal disclaimer is filed herewith to obviate the double patenting rejection. Nevertheless, Applicants do not agree that a *prima facie* case of double patenting has been made. For example, the rejection of claim **19, 20 and 37** is based on the following motivation to modify the patented claims:

"It would have been obvious to one of ordinary skill in the art to modify Patent claims 22 and 23 in order to obtain claim 19 of the instant application."

Office Action, pages 3 and 4.

Clearly, this is not a motivation which the *prior art* provides. Thus, there is no *prima facie* showing that the claims are obvious.

Section 103(a) Rejections

The claims are rejected as being unpatentable over Slezak. Applicants respectfully traverse the Examiner's Section 103(a) rejection. There has been no *prima facie* showing that the claims are obvious.

Limitations Not Disclosed or Suggested

All pending independent claims (and thus all claims) include the following limitation:

"the product information includes information identifying how the product was used in the entertainment program"

(Independent Claims **19, 20 and 37**)

The Examiner alleges that Slezak discloses this limitation:

"Slezak discloses wherein the product information includes information identifying how the product information includes information identifying how the product was used in the program (Col. 4, lines 14-20)"

Office Action, page 5.

However, the cited portion of Slezak merely discloses ...

"Thus, for example, if a viewer selects an action movie as the primary program, if at some point a truck is highlighted in a scene, secondary programming material can be interleaved which presents an advertisement related to a local truck dealer carrying a similar model of truck being shown in the primary programming."

Thus, this portion of Slezak does not disclose or suggest "*information identifying how the product was used in the entertainment program*", which is a feature of all claims. Slezak has nothing to do with *information identifying how the product was used in the entertainment program*.

The remainder of Slezak likewise does not appear to disclose this feature, and the Examiner has not alleged that any other portion of Slezak (or any other reference) suggests this feature.

Since these claim limitations are not suggested by any of the references, a *prima facie* case of unpatentability has not been made.

No Motivation to Modify

There is no motivation to modify the references in a manner which would provide the above limitation of all claims.

In addition, the Examiner has not alleged that any portion of the references would motivate the addition of that limitation.

Accordingly, any argument that there is a motivation to include this limitation in the claims would be a *new ground of rejection*, and thus the next Office Action could not be final.

For example, the following motivation to modify Slezak has been proposed:

"one of ordinary skill in the art would have been obvious to modify Slezak to have a terminal coupled to a central controller (video server 520a of Fig. 1) as a data entry terminal so that a data-entry operator could perform data entry product and product related information, and remotely transmitted to the database that reside remotely from the data entry terminal so to provide to user related addition information of a related product advertisement during the TV program scene as disclosed."

Office Action, page 6.

Clearly, this portion of Slezak has nothing to do with the limitation described above.

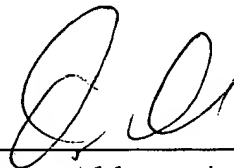
Since no evidence has been provided that the prior art would in any way recognize the desirability of such a modification, a *prima facie* case of unpatentability has not been made.

Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

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